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CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP
STEVEN M. GREENBERG
950 PENINSULA CORPORATE CIRCLE
SUITE 2022
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BELANI, KISHIN G

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRADFORD AUSTIN FISHER
and RANDY ALLAN RENDAHL

Appeal 2009-006321
Application 10/672,777¹
Technology Center 2400

Before JAY P. LUCAS, JOHN A. JEFFERY, and JAMES R. HUGHES,
Administrative Patent Judges.

HUGHES, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING ²

¹ Application filed September 26, 2003. The real party in interest is International Business Machines Corp. (App. Br. 1.)

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

BACKGROUND

Appellants request rehearing of the Decision mailed September 22, 2010, affirming the final rejection of claims 1-11.

The invention at issue on rehearing relates to a system and method for performing a real-time Service Level Agreement (SLA) impact analysis. (Spec. ¶¶ [0001], [0010].)³

Independent claims 1, 4, and 11 illustrate the claims on Rehearing:

1. A method for performing a real-time service level agreement (SLA) impact analysis, the method comprising the steps of:

detecting an event arising from a specific resource;

determining whether based upon said event said specific resource cannot perform adequately to meet a term within an SLA which directly implicates said specific resource; and,

further determining whether based upon said event said specific resource inhibits another resource from performing adequately to meet a term within said SLA which does not directly implicate said specific resource, but directly implicates said another resource.

4. A system of performing a real-time service level agreement (SLA) impact analysis comprising:

a service level manager programmed to establish a plurality of SLAs directly implicating selected resources;

a relationship database configured for coupling to a plurality of management applications programmed to manage said selected resources; and,

³ We refer to Appellants' Specification ("Spec.") (paragraph numbers refer to published application – Pub. No. 2005/0071458 A1); Appeal Brief ("App. Br."); Reply Brief ("Reply Br."); and Request for Rehearing ("Req. Reh'g.") filed November 22, 2010. We also refer to our Decision on Appeal ("Dec.") mailed September 22, 2010.

a modeling and evaluation system communicatively coupled to said relationship database and said service level manager and programmed to perform a real-time SLA impact analysis based both upon resources directly implicated by said SLAs and also upon resources which are related to said resources directly implicated by said SLAs.

11. A method for assessing the impact of an indirectly implicated resource within an service level agreement (SLA) in real time, the method comprising the steps of:

establishing an SLA directly implicating a performance level for an underlying resource;

noting at least one resource upon which said underlying resource depends;

receiving an event arising from said at least one resource;

determining whether said event affects said underlying resource in meeting said performance level; and,

if said event prevents said underlying resource from meeting said performance level, generating a notification specifying an impact of said event upon said SLA.

PRINCIPLES OF LAW

Requests for rehearing must comply with 37 C.F.R. § 41.52(a)(1), and “must state with particularity the points believed to have been misapprehended or overlooked by the Board.” Moreover, requests must specifically recite “the points of law or fact which appellant feels were overlooked or misapprehended by the Board.” (MPEP § 1214.03.)

As we explained in our recent *Frye* decision, the Examiner has the initial burden of production and persuasion – “to set forth the basis for any rejection so as to put the patent applicant on notice of the reasons why the applicant is not entitled to a patent on the claim scope that he seeks — the so-called ‘prima facie case.’” *Ex Parte Frye*, 94 USPQ2d 1072, 1075

(BPAI 2010) (Precedential).⁴ “The term ‘prima facie case’ refers only to the initial examination step.” *Id.* (quoting *Oetiker*, 977 F.2d at 1445). “The ‘prima facie case’ serves as a procedural mechanism that shifts the burden of going forward to the applicant, who must produce evidence and/or argument rebutting the case of unpatentability. *Id.* (citing *Oetiker*, 977 F.2d at 1445; *Piasecki*, 745 F.2d at 1472). “Applicant’s rebuttal evidence ‘may relate to any of the Graham factors including the so-called secondary considerations.’” *Id.* (quoting *Piasecki*, 745 F.2d at 1472 (citations omitted)). “The [E]xaminer then determines patentability ‘on the totality of the record, by a preponderance of the evidence with due consideration to the persuasiveness of argument.’” *Id.* (quoting *Oetiker*, 977 F.2d at 1445).

On subsequent “written appeal of an applicant,” the Board reviews the adverse decision of the Examiner. 35 U.S.C. §6(b) (2006). Appellants may, for example:

attempt to overcome an Examiner’s obviousness rejection on appeal to the Board by submitting arguments and/or evidence to show that the examiner made an error in either (1) an underlying finding of fact upon which the final conclusion of obviousness was based, or (2) the reasoning used to reach the legal conclusion of obviousness. Similarly, [Appellants] may submit evidence of secondary considerations of non-obviousness.

Frye, 94 USPQ2d at 1075.

The panel then reviews the obviousness rejection for error based upon the issues identified by appellant, and in light of the

⁴ See also *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984) (the USPTO has the initial burden of proof “to produce the factual basis for its rejection of an application under sections 102 and 103.” (quoting *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967))).

arguments and evidence produced thereon. *See Oetiker*, 977 F.2d at 1445 (“In reviewing the examiner’s decision on appeal, the Board must necessarily weigh all of the evidence and argument.”) Specifically, the Board reviews the particular finding(s) contested by an appellant anew in light of all the evidence and argument on that issue.

Frye, 94 USPQ2d at 1075 (emphasis added); *see Ex Parte Quist*, 95 USPQ2d 1140, 1142 (BPAI 2010) (precedential).

Thus, as the original panel explained in the Decision, Appellants have the opportunity on appeal to the Board to demonstrate error in the Examiner’s position. (Dec. 11-12 (citing *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006)). Appellants’ filing of a Board appeal:

does not, unto itself, entitle an appellant to de novo review of all aspects of a rejection. If an appellant fails to present arguments on a particular issue . . . the Board will not, as a general matter, unilaterally review those uncontested aspects of the rejection.

Frye, 94 USPQ2d at 1075 (citations omitted).

Thus, the Board will generally not reach the merits of any issues not contested by an appellant. *Cf. In re Baxter Travenol Labs*, 952 F.2d 388, 391 [21 USPQ2d 1281] (Fed. Cir. 1991) (“It is not the function of this court to examine the claims in greater detail than argued by an appellant”) For example, if an appellant contests an obviousness rejection only on the basis that a cited reference fails to disclose a particular limitation, the Board need not review the other, uncontested findings of fact made by the examiner underlying the rejection, such as the presence of uncontested limitations in the prior art. *Cf. In re Reuning*, 276 Fed. Appx. 983, 986 (Fed. Cir. 2008) (nonprecedential) (rejecting Reuning’s argument that the Board erred in affirming the obviousness rejection by failing to “explain how each and every element of the rejected claims is taught by the cited references” as “premised on a mistaken assignment of burdens between the PTO and an applicant-

appellant” and citing applicant’s obligations to respond to a prima facie case with “some argument or evidence”).
Frye, 94 USPQ2d at 1076.

SUMMARY OF REQUEST

Appellants, in their Request for Rehearing, contend that the Board of Patent Appeals and Interferences (the “Board”), in its analysis, mistakenly “either misapprehended and/or overlooked certain arguments presented by Appellants.” (Req. Reh’g 1.) Specifically, Appellants discuss three general contentions and several instances where the Board misapprehended or overlooked Appellants’ arguments. First, Appellants contend the original panel applied the incorrect standard of review, giving deference to the positions asserted by the Examiner and incorrectly requiring that Appellants establish Examiner error (Req. Reh’g. 3-5); and specifically, that the original panel improperly shifted the burden to Appellants to produce evidence and/or persuasive argument to show certain disputed features of claim 1 (Req. Reh’g. 14-15). With respect to claim 1, Appellants contend that “the Honorable Board improperly presumes that the rational underpinning has been presented and then improperly shifts the burden to Appellants to establish ‘such a relationship is beyond the understanding or skill of one skilled in the art’” (Req. Reh’g. 15 (quoting Dec. 19)) – the aforementioned relationship being “that server 1 violating SLO 1 affects how server 2 meets SLO 2” (Req. Reh’g. 14 (quoting Dec. 19)).

Secondly, Appellants generally contend the original panel “failed to consider all of Appellants’ arguments” (Req. Reh’g. 6-7) in that the panel stated “the rejections made in the preceding office actions and any corresponding responses by Appellants are not before the BPAI, and we will

not address any arguments related to prosecution preceding the Last Office Action” (Req. Reh’g. 5 (quoting Dec. 12, note 4) (emphasis added by Appellants)). Additionally, Appellants contend the original panel overlooked Appellants’ argument (and improperly deferred to the Examiner’s findings) concerning whether Bartz discloses “at least one resource upon which said underlying resource depends” as recited in claim 11 (Req. Reh’g. 10-12), in that Appellants:

raised the issue as to whether Bartz teaches that “throughput of a resource such as a storage server will impact the response time of an underlying resource such as a web server,” as alleged by the Examiner, or, as rephrased by the Honorable Board, “where the characteristics described in the SLOs affect one another, for example that the throughput of Server 1 (a storage server) may affect the response time of Server 2 (a web server) or vice versa.”

(Req. Reh’g. 11 (quoting Last Office Action 18; Dec. 13)). “However, neither the Examiner nor the Honorable Board has pointed to any substantial evidence to support this finding.” (Req. Reh’g. 12.) Appellants also contend the original panel overlooked Appellants’ argument (and improperly deferred to the Examiner’s findings) that Barkan fails “to teach the claimed ‘plurality of SLAs.’” (Req. Reh’g. 16.) Appellants further contend the original panel overlooked Appellants’ argument (and improperly deferred to the Examiner’s findings) that:

the Examiner has failed to establish that Barkan teaches the claimed “a modeling and evaluation system communicatively coupled to said relationship database and said service level manager and programmed to perform a real-time SLA impact analysis based both upon resources directly implicated by said SLAs and also upon resources which are related to said resources directly implicated by said SLAs.”

(Req. Reh’g. 16 (quoting claim 4 (and also, in part, App. Br. 18)).)

Third, Appellants generally contend that the original panel's "new findings and new analysis constitute new grounds of rejection." (Req. Reh'g. 7-9.) Specifically, Appellants contend the original panel cited numerous passages of Bartz, not previously cited by the Examiner, "in affirming the Examiner's rejections[, which] constitutes a new grounds of rejection." (Req. Reh'g. 10.) Appellants also contend that the original panel's construction, with respect to claim 11, of several claim terms constitutes a new ground of rejection in that – "none of these claim constructions were presented by the Examiner . . . [and the panel] has advanced positions and/or rationales new to the proceedings, and thus, designation of a new grounds of rejection is necessary." (Req. Reh'g. 12.) Further, Appellants contend that the original panel's construction, with respect to claim 1, of the claim terms "specific resource" and "another resource," as well as its findings that Main describes these resources constitute new grounds of rejection. (Req. Reh'g. 13.)

DISCUSSION

A request for rehearing "must state with particularity the points believed to have been misapprehended or overlooked by the Board" and "must specifically recite 'the points of law or fact which appellant feels were overlooked or misapprehended by the Board.'" *Quist*, 95 USPQ2d at 1141 (quoting MPEP § 1214.03). The Board will not consider any issues or arguments not particularly contested by Appellants. *Frye*, 94 USPQ2d at 1075-76. Although we have reconsidered our September 22, 2010 Decision in light of Appellants' contentions in the Request, we find no errors therein. Thus, we decline to change our prior decision for the reasons that follow,

and consequently, we also decline Appellants request that they be afforded an opportunity to respond to our analysis:

Appellants cannot rely upon the Honorable Board maintaining the same positions in a subsequent Decision as the Honorable Board presented in the current Decision because of these errors. Thus, although Appellants will point out certain errors in the Honorable Board's current analysis, Appellants recognize that any subsequent Decision by the Board will necessarily be different and Appellants should be given the opportunity to address the Honorable Board's new analysis.

(Req. Reh'g. 7.) We note that Appellants may commence a civil action, as recited in 37 C.F.R. § 1.304, or file a request for rehearing, as recited in 37 C.F.R. § 41.52, in response to this decision.

*Issue 1: Standard of Review, Examiner Deference,
and Burden Shifting*

Appellants generally contend the original panel applied the incorrect standard of review, giving deference to the positions asserted by the Examiner (Req. Reh'g. 3-5), and in particular, improperly shifted the burden to Appellants to produce evidence and/or persuasive argument to show – with respect to claim 1 – that the Examiner's finding of “server 1 violating SLO 1 affects how server 2 meets SLO 2” (Req. Reh'g. 14) “is beyond the understanding or skill of one skilled in the art” (Req. Reh'g. 15). Appellants also contend the original panel improperly deferred to the Examiner's findings with respect to certain overlooked arguments. (Req. Reh'g. 10-12, 16.)

We disagree with Appellants that the original panel, generally, used the incorrect standard of review. The original panel's Decision applied the standard of review set out in *Quist* and *Frye* (*supra*) and the Decision

addressed the arguments raised by Appellants in the Appeal Brief and Reply Brief concerning the disputed features of representative claims 1, 4, and 11. Moreover, the factual findings set forth in the Decision substantiate that the record was considered as a whole, including the relevant evidence, giving due consideration to the arguments advanced by Appellants in the Appeal Brief and the argument raised in response to the Examiner's Answer in the Reply Brief.

With respect to claim 1, Appellants mischaracterized the original panel's analysis in the Decision. Appellants contend that the panel "improperly presumes that [a] rational underpinning has been presented [by the Examiner] and then improperly shifts the burden to Appellants to establish 'such a relationship is beyond the understanding or skill of one skilled in the art.'" (Req. Reh'g. 15 (quoting Dec. 19)). We note, however, that the original panel provided detailed fact finding and analysis with respect to the limitations of claim 1, and the prior art references (Main and Bartz). (Dec. 16-19.) In particular, the panel found that "Bartz would have taught or suggested . . . determining based upon an event (an SLO violation for a specific resource) that the specific resource inhibits another resource from performing adequately to meet an SLA term (a second SLO) that does not directly implicate the specific resource." (Dec. 18-19.) The panel then enumerated several reasons for finding Appellants' arguments unpersuasive, including, that Appellants failed to establish the that the "relationship" – "server 1 violating SLO 1 affects how server 2 meets SLO 2" (Req. Reh'g. 14) – "is beyond the understanding or skill of one skilled in the art" (Req. Reh'g. 15). (Dec. 19.)

The original panel properly performed the requisite analysis. The panel discussed the Examiner's rejection, illustrated that the Examiner presented a prima facie basis for obviousness rejection, presented additional explanatory evidence and analysis supporting its finding of no error in the Examiner's rejection, and explained why the Appellants' arguments were unpersuasive. For the reasons set forth in the Decision, and the portions of Main and Bartz cited therein, we disagree with Appellants' unsupported contention that there is insufficient detail in the disclosures of Main and Bartz for shifting the burden of persuasion (for providing evidence and/or persuasive technical rationale) to Appellants to show that Appellants' claimed feature ("determining whether based upon said event said specific resource inhibits another resource from performing adequately to meet a term within said SLA which does not directly implicate said specific resource, but directly implicates said another resource" (App. Br. 22, claim 1)) renders the claim patentably different from the SLAs taught or suggested taught by Main and Bartz.

Once the Examiner presented a basis for the obviousness rejection (the so called "prima facie case"), the burden was with Appellants to show that the Examiner's basis for the rejection was insufficient/faulty, and/or the Examiner's legal reasoning was improper. *Frye*, 94 USPQ2d at 1075. We agree with the original panel that Appellants did not carry that burden. The panel properly reviewed the obviousness rejection for error based upon the issues identified by Appellants, in light of the arguments and evidence produced. *Id.* The original panel did not apply an incorrect standard of review, nor improperly shift the burden of persuasion to Appellants.

Appellants also imply that the original panel applied the improper standard of review with respect to claims 11 (Req. Reh’g. 12) and 4 (Req. Reh’g. 16) by deferring to the Examiner’s findings/positions – “a complete *de novo* review is to be performed on all issues that are raised by Appellants without deference to the positions taken by the Examiner” (Req. Reh’g. 12, 16). As with claim 1 above, the original panel properly applied the standard of review set out in our *Frye* decision, and performed the requisite analysis. The panel discussed the Examiner’s rejection and the Examiner’s prima facie basis for the anticipation rejection (claim 11) and the obviousness rejection (claim 4), presented additional evidence and analysis supporting its finding of no error in the Examiner’s rejection, and explained why the Appellants’ arguments were unpersuasive. (See Dec. 12-15 (claim 11), 21-23 (claim 4).) For the reasons set forth in the Decision, and the portions of Main, Bartz, and Barkan cited therein, we disagree with Appellants’ unsupported implied contention that the original panel improperly deferred to the Examiner’s findings, and that there is insufficient detail in cited references for shifting the burden of persuasion to Appellants to show error in the Examiner’s rejection.

Issue 2: Overlooked Arguments

Appellants generally contend the original panel “failed to consider all of Appellants’ arguments” (Req. Reh’g. 6-7). Appellants further contend that the original panel overlooked Appellants specific arguments: (1) with respect to claim 11, in that Bartz fails to disclose “at least one resource upon which said underlying resource depends” as recited in claim 11 (Req. Reh’g. 10-12); (2) with respect to claim 4, in that Barkan fails “to teach the claimed ‘plurality of SLAs’” (Req. Reh’g. 16); and (3) with respect to claim 4, in that

Barkan fails to teach performing “a real-time SLA impact analysis based both upon resources directly implicated by said SLAs and also upon resources which are related to said resources directly implicated by said SLAs” (Req. Reh’g. 16).

Addressing Appellants’ general contention that the original panel failed to consider arguments because the panel stated that “we will not address any arguments related to prosecution preceding the Last Office Action” (Req. Reh’g. 5), we note that Appellants mischaracterize the panel’s statement and do not specifically point out what, if any, arguments the panel failed to consider. Requests for rehearing “must state with particularity the points believed to have been misapprehended or overlooked by the Board.” 37 C.F.R. § 41.52(a)(1); *see Frye*, 94 USPQ2d at 1075-1076.

The original panel presented Appellants with a reminder or guide for formulating their arguments going forward, not an unequivocal statement of waiver. Moreover, the original panel correctly points out that the Board reviews the rejections of the Examiner made in the final or last office action on appeal to the Board. The Board reviews the adverse decision of the Examiner on “written appeal of an applicant” (35 U.S.C. § 6(b)), and has jurisdiction to review an Examiner’s decision including claims that have been twice rejected. – “An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences.” 35 U.S.C. § 134 (1984); *see Ex parte Lemoine*, 46 USPQ2d 1420, 1422-23 (BPAI 1994); *see also In re Hengehold*, 440 F.2d 1395, 1402-03 (CCPA 1971) (discussing 35 U.S.C. § 134 and the “twice rejected” requirement); *cf. In re Volk*, 634 F.2d 607, 609 (CCPA 1980) (discussing 35 U.S.C. § 134); *In re Voss*, 557 F.2d 812,

816 (CCPA 1977) (discussing 35 U.S.C. § 134). Thus, we disagree with Appellants' general contention that the original panel failed to address any arguments properly presented in Appellants' Briefs.

With respect to claim 11, Appellants assert the original panel overlooked Appellants contention that Bartz fails to disclose certain claimed features (Req. Reh'g. 11-12), in that Appellants:

raised the issue as to whether Bartz teaches that "throughput of a resource such as a storage server will impact the response time of an underlying resource such as a web server," as alleged by the Examiner, or, as rephrased by the Honorable Board, "where the characteristics described in the SLOs affect one another, for example that the throughput of Server 1 (a storage server) may affect the response time of Server 2 (a web server) or vice versa."

(Req. Reh'g. 11 (quoting Last Office Action 18; Dec. 13)).

As explained in detail in the Decision (Dec. 12-15), the original panel agreed with the Examiner's finding that "the Bartz reference discloses the disputed features of an underlying resource and 'at least one resource upon which the underlying resource depends.'" (Dec. 13 (quoting claim 11).) The panel discussed the Examiner's rejection and the Examiner's prima facie basis for the anticipation rejection (Dec. 13), presented additional explanation, analysis, and supporting evidence in support of its finding of no error in the Examiner's rejection (Dec. 13-15), and further explained why the Appellants' arguments were unpersuasive (Dec. 15). In particular, the original panel found that Bartz discloses "multiple interrelated (dependent) resources, e.g., a proxy server and a web server, or as explained by the Examiner, a web server and a storage server" (Dec. 14; *see* FF 1-3 (Dec. 5-7)), and that these interrelated resources anticipate Appellants' recited "'at least one resource upon which the underlying resource depends'" (Dec. 15).

The original panel's discussion of "at least one resource upon which the underlying resource depends" addresses Appellants' assertions that Bartz does not describe "why SLO1 or SLO2 went into non-compliance" and that the panel did not present evidence supporting its finding that "the throughput of Server 1 (a storage server) may affect the response time of Server 2 (a web server) or vice versa." (Req. Reh'g. 11.) For the reasons set forth in the Decision, and the cited portions of Bartz, we disagree with Appellants' contention that the panel overlooked Appellants' arguments.

With respect to claim 4, Appellants assert the original panel overlooked Appellants contention that Barkan fails to teach "the claimed 'plurality of SLAs'" and also

the claimed "a modeling and evaluation system communicatively coupled to said relationship database and said service level manager and programmed to perform a real-time SLA impact analysis based both upon resources directly implicated by said SLAs and also upon resources which are related to said resources directly implicated by said SLAs."

(Req. Reh'g. 16.)

In the Decision, the original panel noted Appellants' arguments that 'Barkan does not teach . . . a plurality of SLAs directly implicating selected resources . . . [and] "performing a real-time SLA impact analysis based both upon resources directly implicated by the SLAs and related resources."

(Dec. 21.) The panel agreed with the Examiner's findings that Barkan describes "a service level manager programmed to establish a plurality of SLAs directly implicating selected resources" (Dec. 21) and "a modeling and evaluation system programmed to perform a real-time SLA impact analysis based both upon resources directly implicated by the SLAs and also related resources" (Dec. 21-22). The panel also presented additional

explanation, analysis, and supporting evidence in support of its finding of no error in the Examiner's rejection. (Dec. 22-23.)

With respect to Appellants' contention regarding a plurality of SLAs, the original panel found that Barkan describes "a system for ASPs to manage SLAs" and "a SLA Database" (Dec. 22), which would have at least suggested a plurality of SLAs. (*See* Dec. 9, FF 7 ("a system enabling service providers (Application Service Providers (ASPs)) to manage Service Level Agreements (SLAs) utilizing the Service Level Agreement Language of Measurement (SLALOM);" or "Barkan's system allows ASPs 'to define SLAs with their customers'" (quoting Barkan col. 1, 1. 21); or "Barkan also describes a central management tool based on SLALOM that allows the ASP to manage all aspects of service agreements – SLAs – between the ASP and its customers").)

With respect to Appellants' contentions regarding performing SLA impact analysis, the original panel found that "Barkan would have taught . . . (3) a modeling and evaluation system – taught by Barkan's SLA Engine and CSL Engine . . . that performs a real-time SLA impact analysis based both upon resources directly implicated by the SLAs – e.g., an application server – and related resources – e.g., related applications such as SAP." (Dec. 23; *see* Dec. 10-11, FF 8-9.) The original panel's discussion of "SLAs" and "a modeling and evaluation system . . . that performs a real-time SLA impact analysis" addresses and contradicts Appellants' assertions that the panel overlooked these contentions and/or did not present evidence supporting its findings concerning these features. For the reasons set forth in the Decision, we disagree with Appellants' contentions that the panel overlooked Appellants' arguments.

Issue 3: New Grounds of Rejection

Appellants generally contend that the original panel made “new findings and new analysis [that] constitute new grounds of rejection.” (Req. Reh’g. 7-10.) Specifically, Appellants contend: (1) the original panel cited numerous passages of Bartz that were not previously cited by the Examiner (Req. Reh’g. 10); (2) with respect to claim 11, the panel’s claim construction constitutes a new ground of rejection in that the construction was not presented by the Examiner and represents a new position or rationale (Req. Reh’g. 12); (3) with respect to claim 1, the panel’s construction of the claim terms and its findings regarding Main constitute new grounds of rejection (Req. Reh’g. 13); and (4) with respect to claim 1, the panel’s newly presented position – that Appellants’ did not show how the Examiner’s finding of “server 1 violating SLO 1 affects how server 2 meets SLO 2” (Req. Reh’g. 14) “is beyond the understanding or skill of one skilled in the art” (Req. Reh’g. 15) – constitutes a new ground of rejection.

In appeals before the Board, the Board must ensure that Appellants are given a fair opportunity to respond to the thrust of a rejection. *See In re Kumar*, 418 F.3d 1361, 1368 (Fed. Cir. 2005) (citing *In re Kronig*, 539 F.2d 1300, 1302 (CCPA 1976)). We agree with Appellants that where the Board advances “a position or rationale new to the proceedings,” Appellants “must be afforded an opportunity to respond to that position or rationale by submission of contradicting evidence” – even if based on evidence previously of record. *In re De Blauwe*, 736 F.2d 699, 706 n.9 (Fed. Cir. 1984). However, it is not a new ground of rejection for the Board to respond to Appellant’s arguments using different language, or restating the reasoning of the rejection in a different way, so long as the evidence relied upon is the

same and the “basic thrust of the rejection” is the same. *Kronig*, 539 F.2d at 1303. In particular, citing to a different portion of an applied reference, which “goes no farther than, and merely elaborates upon, what is taught by” the previously-cited portion of that reference relied upon by the examiner, does not constitute a new ground of rejection. *See In re DBC*, 545 F.3d 1373, 1382 n.5 (Fed. Cir. 2009). Thus, we disagree with Appellants expansive interpretation of *Kumar* that “the introduction of new findings, even though these findings related to a previously-presented rejection, constituted a new grounds of rejection.” (Req. Reh’g. 8.)

With respect to Appellants’ general contention that the newly cited portions of Bartz constitute a new ground of rejection (Req. Reh’g. 10), we note that Appellants do not specifically point out how the newly cited portions change the thrust of the rejection, or even which newly cited portions purportedly change the thrust of the rejection. *See Kumar*, 418 F.3d at 1368; *Kronig*, 539 F.2d at 1303. Requests for rehearing “must state with particularity the points believed to have been misapprehended or overlooked by the Board.” 37 C.F.R. § 41.52(a)(1); *see Frye*, 94 USPQ2d at 1075-1076. Moreover, we disagree that the original panel’s citation of different portions of Bartz constitutes a new ground of rejection, as the cited portions merely elaborates upon and clarify the previously discussed teachings of Bartz relied upon by the Examiner. *See DBC*, 545 F.3d at 1382.

Similarly, with respect to Appellants’ contentions that the original panel’s construction, with respect to claim 11 (Req. Reh’g. 12) and claim 1 (Req. Reh’g. 13), of several claim terms constitute a new ground of rejection, Appellants do not specifically point out how the construction of the claim terms changes the thrust of the rejection – representing a new

rationale or position. To the contrary, the panel merely responded to Appellants' arguments by clarifying the issues and presenting supporting evidence and analysis.

With respect to claim 1, Appellants also contend the original panel's construction of the claim terms "specific resource" and "another resource," in conjunction with its findings that Main describes these resources, constitute a new ground of rejection (Req. Reh'g. 13) because "the Honorable Board's finding as to what constitutes a 'resource' is entirely different than the analysis presented by the Examiner" (Req. Reh'g. 14). Appellants mischaracterize the panel's findings, and again fail to explain how the panel's findings change the thrust of the rejection. Specifically, the panel found that:

we broadly but reasonably construe Appellants' recited resources – Appellants' "specific resource" and "another resource" – as meaning a source of something useful, such as a source of information or a service provider, or an asset, for example, a data processing job performed by a mainframe computer or a computing resource such as CPU time.

(Dec. 16-17.) Additionally, the original panel found that Main teaches "ABENDs or waiting on resources such as memory" and "specific resources (processing jobs and/or computer resources) utilized to perform a task . . . related to the resources." (Dec. 18.) Thus, we understand the original panel found that Main describes or at least suggests batch data processing jobs performed by a mainframe computer (an asset), using resources such as CPU time or memory, to perform certain tasks. (*See* Dec. 7-9, FF 4-6.) It is unclear how such a construction of "resources" changes the thrust of the Examiner's argument in view of the Examiner's findings concerning resources and ABENDs. (*See* Ans. 5, 20-22 (discussing Main's disclosure

of computing resources such as main frame computers (including resources such as CPUs and memory) that run batch jobs, as well as ABENDs that implicate resources such as CPU time, memory space and disk storage).)

Appellants further contend, with respect to claim 1, that the original panel's position – that Appellants' did not show how the relationship ("server 1 violating SLO 1 affects how server 2 meets SLO 2" (Req. Reh'g. 14)) "is beyond the understanding or skill of one skilled in the art" (Req. Reh'g. 15) – constitutes a new ground of rejection because the position was never presented by the Examiner. (Req. Reh'g. 15).

Appellants do not explain how the panel's position changes the thrust of the rejection. We disagree with Appellants' assertion that the panel's explanation is a new rationale, much less a new rationale or position warranting a new ground of rejection. To the contrary, the panel merely responded to Appellants' arguments by enumerating several reasons for finding Appellants' arguments unpersuasive, including, that Appellants failed to establish the that the "relationship" was "beyond the understanding or skill of one skilled in the art" (Req. Reh'g. 15). (Dec. 19.) For the reasons set forth in the Decision and above, we disagree with Appellants' contention that the panel presented new rationale or positions warranting any new ground of rejection.

CONCLUSION

We are of the opinion that the original panel correctly concluded upon consideration of all of the evidence and argument of record that the applied prior art properly anticipates (under 35 U.S.C. § 102(e)) or renders obvious

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(under 35 U.S.C. § 103(a)) the claimed subject for reasons stated in the Decision and as set forth by the Examiner in the Answer.

ORDER

We have granted Appellants' Request to the extent we have reconsidered the Decision as indicated above, but we decline to make any substantive change therein.

DENIED

msc

Carey, Rodriguez, Greenberg & Paul, LLP
Steven M. Greenberg
950 Peninsula Corporate Circle
Suite 3020
Boca Raton, FL 33487